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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,252	09/29/2000	Satoshi Washizuka	1035-283	1246
7590 03/24/2004				
NIXON & VANDERHYE P.C. 8th Floor 1100 North Glebe Road Arlington, VA 22201-4714			EXAMINER PATEL, JAGDISH	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/675,252	<b>Applicant(s)</b> WASHIZUKA ET AL	
	<b>Examiner</b> JAGDISH N PATEL	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4, 12/20/2000</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Specification***

1. The abstract of the disclosure is objected to because the abstract of contains more than 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. As an example claims 1-19 recite phrases such as "wherein ..said paying means for applying accounting in transactions between buyer and a supplier;", "claiming means for claiming a counter value in the transactions", "when judges satisfy," "purchases acknowledgement data", "so as to redeem money" and "purchasing in said reconciliating means the electronic record data from said claiming means" .

Recitation of phrases such as those exemplified above renders the claims incomprehensible and therefore indefinite.

The applicant is required to present claims in a manner that conform to the requirements set forth in the MPEP.

The structure which goes to make up the device must be clearly and positively specified. The process steps must be organized and correlated in such a manner as to present a complete operative method or apparatus. Furthermore, The claim(s) must be written in a format that conforms to the format adopted for the US patent applications as set forth in the following paragraphs.

In support of this contention, the examiner cites the following requirement of 37 CFR 1.75 regarding claim structure.

Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

The claims are presented in narrative form without clearly specifying meets and bounds of the elements in terms of means and corresponding function. The presentation of claim in this manner is defective because the scope of the claimed invention cannot be ascertained with degree of accuracy required for examination as per requirements outlined above.

For example, claim 1 recites a limitation in a narrative form as follows:

"said paying means includes first data processing means which creates accounting application data for applying for accounting and account reconciliation for products or services ordered by the buyer to the supplier, and which sends the accounting application data to said

reconciliating means via said first communicating means and when the products or services are supplied to the buyer from the supplier, said first data processing means creates acknowledgement data which indicates supplied content and sends the acknowledgement data to said claiming means via said first communicating means”

It is unclear from the above recitation which element of the claimed system is being limited since it presented in a narrative or descriptive form.

Please note that only exemplary deficiencies are cited. The applicant is requested to review the specification and the claims to ensure that similar deficiency are corrected as appropriate.

The claims are further examined as best interpreted from the defective recitation.

4. Claims 1-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1-14 recite the limitation "said accounting and account reconciliating system for carrying out accounting and account reconciliation" There is insufficient antecedent basis for this limitation in the claim (s) because "accounting and account reconciliating system" itself is not a limitation.

6. Claim 2 recites limitation "said third data processing means" and "said first data processing means". There is insufficient antecedent basis for these limitations in the claim (s) because "first data processing means" and "first data

processing means" are not recited as elements of the system per claim 1.

Dependent claims 3 and 4 also inherit same deficiencies and claims 5-14 also recite limitations which lack antecedent basis.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system (paying means and claiming means) and subsequently the claim then deals with the specifics of a method step (creating..., purchasing)..

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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9. Claims 16, 17 and 19 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claim 16), the body of the claim discusses the specifics of the system (paying means, reconciliating means, etc.) and method (creating..application data, etc.). "A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

10. Claims 17 and 19 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. claim 17 recites a server having a plurality of elements, each in the form of computer executable codes (means for establishing communications, credit data creating means, delivery list creating means, and counter value claiming means) which are capable of interacting with each other. However, the system is rendered non-functional and inoperative because there is nothing in the claimed system to impart functionality of these computer codes. Note that functionality of the computer executable codes is realized only, when they are acted upon by a processor or a computing device.

This deficiency is also present in independent claim 17 and 19.

The pending claims 1-19 have been examined as best interpreted and understood by the examiner.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1, 16-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Mori et al. (US Pat. 6,085,168) (hereafter Mori).

Per claim 1 Mori discloses an accounting and account reconciling system which includes:

paying means including first communicating means for establishing communications, said paying means for applying for accounting in transactions between a buyer and a supplier;

(Fig.1 item 1 purchaser's processing unit, Fig. 2 refer to corresponding function goods purchase request from A)

reconciling means including second communicating means for establishing communications, said reconciling means for arbitrating account reconciliation in the transactions;



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(Fig. 2 col. 3 DB 30 and 31, refer also to corresponding description at col. 16+)  
and

claiming means including third communicating means for establishing communications, said claiming means for claiming a counter value in the transactions

(Figure 2, col. 3 "final settlement" refer also to corresponding description at col. 16+)

Claim 16 is interpreted to read as a method claim that performs processes of method claim 1 and according rejected in view of same analysis.

Per claim 17. Mori discloses an account reconciling server which guarantees account reconciliation in transactions between paying means which creates accounting application data for applying for accounting with respect to products or services ordered by a buyer to a supplier and claiming means by which the supplier claims a counter value, said account reconciling server comprising:

communicating means for establishing communications with each of said paying means and said claiming means;

(Fig. 21 communication control unit 1020)

credit data creating means for creating, based on the accounting application data received, credit data including information which specifies transaction conditions of the products or services, and sending the credit data created to said claiming means, said credit data for guarantee of account reconciliation of the products or services supplied;

(1500 transaction management processing unit which interacts with operational control unit 1010 and database control unit 140, see Fig. 21)

delivery list creating means which, when received from the supplier products or services which are based on content of the credit data and when the content satisfies the transaction

conditions in the credit data, pays a counter value of the products or services to the claiming means, and creates delivery list data which indicates supply content of the products or services, and sends the delivery list data created to said paying means; and

(1500 transaction management processing unit which performs "goods delivery receipt" and "goods delivery acceptance" process)

counter value claiming means which, when received from said paying means acceptance data for the delivery list data, supplies the products or services supplied by the supplier to the buyer, and claims the buyer for a counter value of the products or services so as to redeem the counter value.

(1500 transaction management processing unit which performs "Final settlement request process" and "Final settlement admission process")

Claim 18. As best understood claim 18 is interpreted and analyzed as per claim 1.

Claim 19. As best understood claim 19 is interpreted and analyzed as per claim 17.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

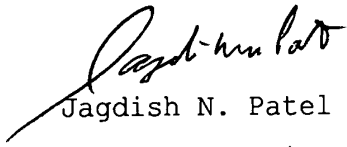
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.



Jagdish N. Patel

(Primary Examiner, AU 3624)

4/17/2004